

**REMARKS**

In the Office Action, the Examiner objected to the abstract of the disclosure and objected to claims 1-26. Each of the Examiner's objections is discussed below, along with an appropriate explanation or remedy.

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**Objection under MPEP § 608.01(b)**

The specification is objected to and correction of the abstract of the disclosure is required under MPEP § 608.01(b), for exceeding 150 words and for not clearly and concisely defining the invention.

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Applicant has cancelled the abstract of the disclosure and replaced it with an easy-to-read, 69-word paragraph that summarizes the invention, with emphasis on the unique features. Withdrawal of this rejection is respectfully requested.

**Objection for Improper Format**

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Claims 7, 13, 14, 15, 19, 23, 24, and 25 stand objected for improper usage of squares or stars in the claim. Applicant has canceled these claims and added new claims without squares or stars. Withdrawal of this objection is respectfully requested.

**Rejection Under 35 USC 112, second paragraph**

Claims 1-26 stand rejected under 35 USC 112, as being indefinite. While Applicant is of the opinion that these claims are in fact definite, Applicant has canceled all of these claims and added new claims that clearly define the invention. More particularly, Applicant addresses each of the Examiner's objections, as follows:

-- *Claims 1, 16, and 18.* With regard to the rejection of claims 1, 16, and 18, the Examiner objects to the language used to issue awards, particularly the words "at least" in lines 11 and 14. These claims have been canceled.

Claims 27, 40, 41, and 52-57 replace claims 1, 16, and 18. The new claims use language that clearly and concisely describes the method of issuing awards. Further, all of the new claims are composed without use of the words "at least."

The language of claims 27, 40, 41, and 52-57 refer to awards for symbols appearing adjacent to each other in the symbol matrix, such that any two or more adjacent symbols may result in an award. For example, the language of claim 40, sub-section (e), as follows:

"issuing awards based upon the appearance of two or more same symbols wagered upon appearing with (1) said symbols in adjacent to each other in the symbol matrix; (2) with said symbols adjacent to each other in horizontal or diagonal directions; (3) with at least one of said symbols appearing in the leftmost column of the symbol matrix; and (4) with at most one of said symbols appearing in each column of the symbol matrix" (emphasis added).

By way of illustration, the language of claim 40 results in two winning symbol combinations of A(1)-A(2)-A(3)-A(4) and A(1)-A(2)-A(3)-A(5)-A(6), in the example below:

A(1)	–	A(2)	–	B	–	A(5)	–	A(6)
C	–	D	–	A(3)	–	G	–	E
F	–	G	–	C	–	A(4)	–	F

The combination of A(1)-A(2)-A(3)-A(4) uses four, same, adjacent symbols, in horizontal (i.e. A(1) and A(2)) or diagonal (i.e. A(2) and A(3)) directions, with an “A” in the leftmost column (i.e. A(1)) and at most one “A” in each of the columns.

The combination of A(1)-A(2)-A(3)-A(5)-A(6) uses five, same, adjacent symbols, in horizontal (i.e. A(5) and A(6)) or diagonal (i.e. A(3) and A(5)) directions, with an “A” in the leftmost column (i.e. A(1)) and at most one “A” in each of the columns.

-- *Claims 9, 13, 19, 23, and 24.* With regard to the rejection of claims 9, 13, 19, 23, and 24, the Examiner objects to the use of parenthesis and the phrases within the parenthesis. Applicant has canceled these claims and added new claims without parenthesis.

-- *Claims 9, 14, and 19.* With regard to the rejection of claims 9, 14 and 19, the Examiner objects to the term “most valuable winning combination” as insufficient to describe how such a combination is determined. These claims have been canceled.

Claims 49 and 50 replace claims 9, 14, and 19. The new claims use language that clearly and concisely describes the method of creating a winning combination by repositioning a symbol to another position in the symbol matrix.

-- *Claims 17 and 25.* With regard to the rejection of claims 17 and 25, the Examiner objects to the use of term "same and different" to describe the relationship of symbols. Applicant has canceled these claims and added claims without this terminology.

Claims 34, 35, 40, 52, 56 and 57 replace claims 17 and 25. The new claims 34, 40, 52, 56 and 57 use the term "same" by itself to describe the relationship of like symbols; claim 35 uses the term "different" by itself to describe the relationship of unlike symbols.

-- *Claim 26.* With regard to the rejection of claim 26, the Examiner objects to the phrase "the predetermined contiguous lines" in lines 12-13. Applicant has canceled these claims and added claims without reference to "lines" of any kind.

For these reasons and the reasons discussed above, Applicant respectfully submits that the rejections to claims 1-26 have been overcome by claims 27-57 and, therefore, claims 27-57 satisfy the requirements under 35 USC Section 112, second paragraph. Withdrawal of this rejection is respectfully requested.

### **Rejection Under 35 USC 103**

Claims 1-26 stand rejected under 35 USC 103 as unpatentable over Bennett (US Patent No. 6,093,102) in light of Seelig (US Patent No. 6,533,660). Applicant respectfully submits that Bennett and Seelig are unrelated to the present application and provide no grounds for rejection.

*Bennett.* Bennett describes a slot machine game in which a player defines a pay line by selecting a position from each column in the symbol matrix. The game then issues awards for pre-determined combinations of symbols appearing in the player defined pay line. Bennett,

therefore, relies upon the location of symbols (i.e., any symbol in that location) relative to positions in the symbol matrix to select the specific payline the player will be awarded. Thus, Bennett relates to a mechanism for allowing the player to select a specific payline from the total number of possible 243 pay line combinations. (Bennett, Column 3, lines 37-60).

5           Unlike Bennett, the present application does not use any pay lines. Winning combinations are determined by adjacency of symbols wagered upon by the player, without regard to the specific location of those symbols in the symbol matrix. The present application, therefore, relies upon the location of symbols relative to each other.

10           *Seelig*. Seelig describes prize-ball games based upon the illusory selection of a prize ball from a ball holder. The player is shown a number of display balls agitated in a ball holder and then shown a particular prize ball that determines the outcome. The prize ball, however, is not selected from the display balls but from a separate collection of prize balls.

15           Seelig also describes the devices used to create the illusion of selecting the prize-ball from the display balls, including: a Jumbled Ball Display to hold a plurality of display balls; a Ball Selector used to select a prize ball from a separate collection of prize-balls; a Display Device used to display the selected prize ball.

20           Unlike Seelig, the present application uses a slot machine game, with reel strips, spinning slot reels, and symbol matrices, to determine an outcome. There are no prize balls, prize-ball games or prize-ball devices. The present application and Seelig, therefore, are different types of casino games, with differing methods of generating outcomes having significantly different probabilistic outcomes and game rules.

Further, unlike Seelig, the present application does not seek to deceive the player as to method of achieving an outcome. The symbols displayed in the symbol matrix are the actual symbols that determine outcomes. For example, in claim 27, awards are based upon the location of symbols wagered upon relative to each other, as displayed to the player in the symbol matrix.

5           Applicant respectfully submits that the present application may be generally distinguished over Bennett alone, and/or in combination with Seelig. Applicant respectfully submits that independent claims 27, 40, 41, and 52-57 may be distinguished over Bennett and/or Seelig for the following reasons.

10           Claim 27 recites, for example, “wagering upon at least one symbol from the plurality of symbols;” and “issuing awards based upon the appearance of two or more symbols wagered upon appearing in adjacent to each other in the symbol matrix” (emphasis added), in combination with the remaining elements of claim 27.

15           As discussed above, Bennett does not determine outcomes based upon adjacency or any other relative positioning of symbols to each other. Instead, Bennett determines outcomes based upon the location of symbols in the symbol matrix in accordance with standard paylines. The appearance of symbols in positions selected by the player, the game, or in any other manner stand inapposite to adjacency of symbols, as recited in claim 27 of the present application.

20           As also discussed above, Seelig is not a slot machine game and does not use a symbol matrix to determine outcomes. Instead, Seelig uses prize balls to determine outcomes. According to Seelig, the method of selecting of prize balls is designed to deceive the player as to the origin of the prize ball. The selection of prize balls, via deception or any other manner, to

determine outcomes stands inapposite the use and/or selection of slot symbols, in particular adjacent slot symbols, as recited in claim 27 of the present application in combination.

*Bennett in light of Seelig.* Since neither Bennett nor Seelig relate to the present application, Applicant respectfully submits that the Examiner has failed to provide any motivation and/or suggestion to combine Bennett in the first instance, and even if combined, the present application may also be distinguished from any combination of Bennett and Seelig and, therefore, claims 27-57 are not obvious when Bennett is viewed in light of Seelig.

In relying upon Bennett in light of Seelig, the Examiner states that “[i]t would thus be obvious to the system of Bennett, which grants the player the freedom to construct paylines, that by incorporating the teachings of Seelig, a player could choose symbols in order to construct the paylines” (emphasis added; Office Action, pages 6-7).

Applicant respectfully submits that the Examiner’s assertion misconstrues the nature of pay lines. Pay lines are comprised of pre-determined positions in the symbol matrix. For example, the middle position of each reel may define a pay line. Symbols are not pre-determined positions in a symbol matrix and, therefore, symbols cannot define a pay line.

Further, the Examiner does not recognize the novel nature of the present invention. As discussed above, the present application does not use pay lines of any kind to determine outcomes. Instead, the present application generates outcomes unique to the adjacency method. For example, adjacency and pay lines generate different outcomes for the following spin:

B	–	A(2)	–	D	–	C	–	A(6)
A(1)	–	C	–	F	–	A(5)	–	D
F	–	A(3)	–	A(4)	–	B	–	A(7)

**Using adjacency**, as defined by the language of claim 40, there are three winning symbol combinations of two or more, same symbols, with a symbol the leftmost column and only one symbol used in each column: the first combination uses the two adjacent symbols of A(1)-A(2); the second combination uses the five adjacent symbols of A(1)-A(3)-A(4)-A(5)-A(6); and the third combination uses the five adjacent symbols of A(1)-A(3)-A(4)-A(5)-A(7).

**Using 15 traditional pay lines and a 16<sup>th</sup> player selected pay line**, as listed in the table below, there are five winning symbol combinations of two or more same symbols on the pay lines: the first combination of A(1)-A(2) appears on pay line 6; the second combination of A(1)-A(3) appears on pay line 7; the third combination of A(1)-A(2) appears on pay line 14; the fourth combination of A(1)-A(3) appears on pay line 15; and the fifth combination of A(1)-A(3)-A(4)-A(5) appears on pay line 16.

Pay Line	Position 1		Position 2		Position 3		Position 4		Position 5	
	Col	Row	Col	Row	Col	Row	Col	Row	Col	Row
1	1	2	2	2	3	2	4	2	5	2
2	1	1	2	1	3	1	4	1	5	1
3	1	3	2	3	3	3	4	3	5	3
4	1	1	2	2	3	3	4	2	5	1
5	1	3	2	2	3	1	4	2	5	3
6	1	2	2	1	3	2	4	3	5	2
7	1	2	2	3	3	2	4	1	5	2
8	1	1	2	1	3	2	4	3	5	3
9	1	3	2	3	3	2	4	1	5	1
10	1	1	2	1	3	2	4	2	5	2
11	1	3	2	3	3	2	4	2	5	2
12	1	2	2	2	3	2	4	1	5	1
13	1	2	2	2	3	2	4	3	5	3
14	1	2	2	1	3	2	4	1	5	2
15	1	2	2	3	3	2	4	3	5	2
16	1	2	2	3	3	3	4	2	5	2



Based upon this illustrative example and reasons discussed above, Applicant respectfully submits that the present application may be generally distinguished over Bennett in light of Seelig. Thus, Applicant respectfully submits that the combination of limitations in claim 27 patentably distinguishes over Bennett and Seelig, when claim 27 is interpreted as a whole.

5           With respect to claim 40, Applicant respectfully submits that this claim recites similar features as claim 27, with three award requirements recited at 40(d)(2)-(4), and therefore the combination of limitations recited in claim 40 patentably distinguishes over Bennett and Seelig, for some of these reasons, and the reasons discussed in connection with claim 27.

10           With respect to claim 41, Applicant respectfully submits that this claim recites similar features as claim 27, along with a symbol repositioning feature at 41(d), and therefore the combination of limitations recited in claim 41 patentably distinguishes over Bennett and Seelig for some of these reasons, and the reasons discussed in connection with claim 27.

15           With respect to claim 52, Applicant respectfully submits that this claim recites similar features as claim 27, along with a symbol repositioning feature at 52(d) and three award requirements recited at 52(e)(2)-(4), and therefore patentably distinguishes over Bennett and Seelig for some of the reasons discussed in connection with claim 27, as well as the independent combination of limitations recited in claim 52 when interpreted as a whole.

20           With respect to claim 53, Applicant respectfully submits that this claim recites similar features as claim 27, with a general wagering requirement at 53(a) and a symbol repositioning feature at 53(d), and therefore patentably distinguishes over Bennett and Seelig for some of the reasons discussed in connection with claim 27, as well as the independent combination of limitations recited in claim 53 when interpreted as a whole.

With respect to claim 54, Applicant respectfully submits that this claim recites similar features as claim 27, with a general wagering requirement at 53(a), and therefore patentably distinguishes over Bennett and Seelig for some of the reasons discussed in connection with claim 27, as well as the independent combination of limitations recited in claim 54 when interpreted as a whole.

With respect to claim 55, Applicant respectfully submits that this claim recites similar features as claim 27, without any requirement to wager and with an award requirement recited at 55(c)(2), and therefore patentably distinguishes over Bennett and Seelig for some of the reasons discussed in connection with claim 27, as well as the independent combination of limitations recited in claim 55 when interpreted as a whole.

With respect to claim 56, Applicant respectfully submits that this claim recites similar features as claim 27, without any requirement to wager and with two award requirements recited at 56(c)(2)-(3), and therefore patentably distinguishes over Bennett and Seelig for some of the reasons discussed in connection with claim 27, as well as the independent combination of limitations recited in claim 54 when interpreted as a whole.

With respect to claim 57, Applicant respectfully submits that this claim recites similar features as claim 27, without any requirement to wager and with three award requirements recited at 57(c)(2)-(4), and therefore patentably distinguishes over Bennett and Seelig for some of the reasons discussed in connection with claim 27, as well as the independent combination of limitations recited in claim 54 when interpreted as a whole.

In addition, the present invention provides benefits which are not provided by in Bennett and Seelig, including but not limited to the following alternative benefits:

-- Unique winning combinations of adjacent symbols, as opposed to the repetitive winning combinations of symbols on overlapping pay lines;

-- Simple to understand winning combinations of adjacent symbols, as opposed to the memorization of dozens of positions used in pay lines; and

5           -- Fewer "near-miss" outcomes, as opposed to the frequent frustration of winning symbols appearing above or below pay line positions.

-- No additional devices to determine outcomes, as opposed to the costs and complications imposed by the attachment of ball holder, ball selector and ball display device devices to a primary gaming apparatus; and

10           -- No deceit as to the source of the outcome, as opposed to the illusion required to trick the player into believing that the prize ball originates in the ball holder.

For these reasons and the reasons discussed above, Applicant respectfully submits that independent claims 27, 40, 41, and 52-57, are patentable over the combination of Bennett and Seelig. Withdrawal of this rejection is respectfully requested.

15           Further, dependent claims 28-39 and 42-51, which depend upon independent claims 27 and 41, directly or indirectly, and incorporate the limitations of claims 27 and 41, also include additional limitations not shown or suggested by the prior art. Applicant respectfully submits that these dependent claims 28-39 and 42-51, may also be distinguished over Bennett and Seelig when each claim is interpreted as a whole.

With regard to rejection of claims 2, 3, 7, and 16-17, the Examiner states that “[t]hus, it would be obvious to one of ordinary skill in the art that when incorporating the teachings of Seelig wherein the paylines would be defined based on a symbol chosen by the player not the locations chosen. One of ordinary skill in the art would understand that standard paylines would  
5 be used to ascertain winning combinations” (emphasis added; Office Action, page 7). In addition, the Examiner contends that “the claimed paylines and paytables are known in the art.” Applicant completely disagrees with the Examiner, particularly because Applicant is not claiming any paylines in the present invention. It appears that the Examiner is using personal knowledge, and therefore, applicant respectfully request that the Examiner provide an affidavit  
10 under 37 CFR 1.104(d)(2) to specifically detail this personal knowledge. In the alternative, applicant requests the Examiner to provide a prior art reference or withdraw the rejection on this ground.

Again, Applicant respectfully submits that the Examiner’s assertion misconstrues the nature of pay lines. As discussed above, it is not possible to define a pay line based upon the  
15 selection of symbols. Further, the present application does not rely upon “standard” pay lines or pay lines selected by the player to determine outcomes. Withdrawal of this rejection is respectfully requested.

With regard to rejection of claims 4-6, the Examiner states that “[t]hus, in the system of Bennett in view of Seelig, the combination would yield a game wherein the symbols are chosen  
20 by the player in order to construct a pay line and when a symbol is chosen, it is wagered upon...” (emphasis added; Office Action, page 8). Applicant respectfully submits that the Examiner’s assertion again relies upon the flawed understanding of pay lines and ignores the novel non-pay

line methodology of the present application. Withdrawal of this rejection is respectfully requested.

In further commentary on wagering upon symbols, the Examiner states that “[i]n application of Seelig, one of ordinary skill in the art would understand that the symbols were being wagered on and a number of symbols could thus be chosen” (emphasis added; Office Action, page 7-8). Applicant respectfully submits that Seelig neither considers wagering upon a symbol in any embodiment nor mentions wagering upon symbols in any of the claims.

In Seelig, the only reference to wagering occurs in the Description of the Preferred Embodiment and describes wagering upon a separate gaming apparatus and game. Specifically, Seelig recites:

Game apparatus 20 may be any of a large number of devices that are adapted to allow players to play a game... Means may also be provided for accepting wagers, such as a coin slot 21 or card reader 25... In at least one preferred embodiment, game apparatus 20 is an S Plus model gaming device available from International Game Technology in Reno, Nev” (see Description of Preferred Embodiment, Game Apparatus; page 8, lines 20-26).

Thus, for these reasons and reasons discussed above, Applicant respectfully submits that Bennett in light of Seelig cannot be viewed as anticipating wagering upon a symbol or receiving awards based upon appearance of these symbols appearing adjacent to each other in the symbol matrix. Withdrawal of this rejection is respectfully requested.

With regard to rejection of claim 8, the Examiner states that “it is notoriously well known in the art to use a wild symbol as one of the plurality of available symbols in a slot machine matrix, and the usage of such would be obvious to a skilled artisan as a means to supplement a

5 payline” (emphasis added; page 8). As discussed above, the present application does not use pay lines and, therefore, cannot use wild symbols to supplement a pay line. Further, Applicant has removed all references to wild symbols in claims 27-57. Applicant requests the Examiner to provide an affidavit under 37 CFR 1.104(d)(2) showing that the use of wild symbols in connection with the combination of limitations recited in claim 8 is well know, and if not, provide a prior art reference or withdraw the rejection. Withdrawal of this rejection is respectfully requested.

10 With regard to rejection of claims 9-12, 15, 19-22 and 25, the Examiner states that “[b]onus games including repositioning, moving a character, or choosing hidden items are known in the art...[s]uch attractions would be obvious to the system of Bennett in view of Seelig to further attract players and keep them at machines” (Office Action, page 8). Applicant respectfully submits that the symbol repositioning bonus feature, as recited in claims 41-53, generates awards based upon adjacency of the repositioned symbol to other symbols and, therefore, is not shown or suggested by Bennett, Seelig or other prior art. Applicant requests the Examiner to provide an affidavit under 37 CFR 1.104(d)(2) showing that the use of bonus games  
15 in connection with the combination of limitations recited in the claims is well know, and if not, provide a prior art reference or withdraw the rejection. Withdrawal of this rejection is respectfully requested.

20 With regard to rejection of claims 13-14 and 23-24, the Examiner states that “scatter pays and moving symbols are also well known on the art and thus would be obvious to a skilled artisan” (Office Action; page 9). As for scatter pays, Applicant has removed all references to such pays in claims 27-57. As for moving symbols, Applicant respectfully submits that the symbol repositioning bonus feature, as recited in claims 41-53, generates awards based upon

adjacency of the repositioned symbol to other symbols and, therefore, is not shown or suggested by Bennett, Seelig or other prior art. Withdrawal of this rejection is respectfully requested. Applicant requests the Examiner to provide an affidavit under 37 CFR 1.104(d)(2) showing that the use of scatter pays in connection with the combination of limitations recited in the claims is well know, and if not, provide a prior art reference or withdraw the rejection. Withdrawal of this rejection is respectfully requested.

Thus, for these reasons and the reasons discussed above, Applicant respectfully submits that the objections to claims 1-26 have been overcome by claims 27-57 and, therefore, claims 27-57 satisfy the requirements under 35 USC Section 103. Withdrawal of this rejection is respectfully requested.

#### **Rejection Under 35 USC 103(a)**

Claim 26 stands rejected under 35 USC 103(a) as unpatentable over Bennett (US Patent No. 6,093,102). Applicant respectfully submits that Bennett is unrelated to the present application and provides no grounds for rejection.

With regard to rejection of claim 26, the Examiner describes how Bennett issues awards for combinations of symbols appearing in player selected pay line positions and then states that “[i]t is known in the art that for a payline to be a winning line, the payable is set by the designer and is known to require at least [sic] two of the same symbol appearing on the line” (emphasis added; Office Action, page 10). Applicant respectfully submits that the present application does not use pay lines positions to determine outcomes. As discussed above, the present application

determines outcomes based upon the adjacency of symbols to each other. Withdrawal of this rejection is respectfully requested. Applicant requests the Examiner to provide an affidavit under 37 CFR 1.104(d)(2) showing that the payable is known in connection with paylines with the combination of limitations recited in the claims is well know, and if not, provide a prior art reference or withdraw the rejection. Withdrawal of this rejection is respectfully requested.

### Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the present application is a novel method of playing a slot machine game and prior art does not show or suggest the combination of features recited in claims 27-57. Thus, Applicants respectfully request that claims 27-57 be passed to issue. If there are any matters that would delay this Application from passing to issue, the Examiner is requested, at the earliest convenience, to telephone the undersigned.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.



Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicant reserves the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents.

For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

#### **AUTHORIZATION**

The Commissioner is hereby authorized to charge the extension of time fee, as set forth in 37 C.F.R. 1.17(a), along with any other fees required for this Amendment to Deposit Account No. 08-0219.

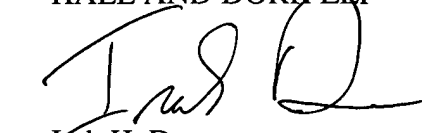
In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby

Appl. No. 09/939,787  
Amdt. dated March 24, 2004  
Reply to Office Action of September 24, 2003

authorized to charge any fee for such an extension or credit any overpayment for an extension of  
time to Deposit Account No. 08-0219.

Respectfully submitted,

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